

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-16 are presently active in this case. The present Amendment amends Claims 1, 6-7, and 10-14 and adds new Claims 15-16 without introducing any new matter.

In the outstanding Office Action, Claim 1 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan et al. (U.S. Patent No. 6,075,982, herein “Donovan”) in view of Kennedy, III et al. (U.S. Patent No. 6,009,330, herein “Kennedy”) and Ekstrom (U.S. Patent No. 6,052,597). Claims 2-3 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Ekstrom in view of Walker (U.S. Patent No. 5,825,863) and further in view of Kasai et al. (U.S. Patent No. 5,815,560, herein “Kasai”). Claim 4 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy, Ekstrom, and in view of Walker, Kasai and Alvesalo (U.S. Patent No. 5,384,824). Claim 5 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy, Ekstrom, and in view of Walker. Claims 6 and 13 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Ekstrom, and in view of Joensuu et al. (U.S. Patent No. 5,966,653, herein “Joensuu”). Claims 7, 9 and 11 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Ekstrom, and in view of Kasai. Claim 8 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy, Ekstrom, and in view of Kasai and Sjödin (U.S. Patent No. 6,631,140). Claims 10 and 14 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Ekstrom, and in view of Kasai and Joensuu. Claim 12 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Ekstrom, and in view of Kasai, Sjödin and Joensuu.

First, Applicants wish to thank Examiner Bhattacharya for the courtesy of an interview granted to Applicants' representative on December 15, 2005, at which time the outstanding issues in this case were discussed. Arguments similar to the ones developed hereinafter were presented and the Examiner indicated that he would reconsider the outstanding grounds for rejection upon formal submission of a response.

To clarify Applicants' invention, independent Claims 1 and 7 are amended to recite "the message including information which requests a call."¹ Claims 1 and 7 are further amended to recite "message" instead of "short message," and to delete "desired" for clarification. Furthermore, dependent Claims 6 and 10 are amended to recite that the message can also be a short message, and Claims 10-14 are also amended to be consistent with the changes to the independent claims. Since the changes are supported by the specification as originally filed, the changes are not believed to raise a question of new matter.

To vary the scope of protection recited in the claims, new Claims 15-16 are added. New Claims 15 and 16 depend upon Claims 1 and 7, respectively, and recite features regarding instructions for the callback computer.² Since the new claims find non-limiting support in the disclosure as originally filed, they are not believed to raise a question of new matter.³

In response to the rejection of independent Claim 1 under 35 U.S.C. §103(a), Applicants respectfully requests reconsideration of this rejection and traverse the rejection, as discussed next.

Briefly recapitulating, Applicants' independent Claim 1 relates to a telecommunications method for establishing a connection with a mobile device of a

¹ Finds non-limiting support in Applicants' disclosure as originally filed, for example at page 2, lines 3-8, page 10, lines 8-14

² Idem for example from page 3, line 25 to page 4, line 13.

³ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

participant. The method includes, *inter alia*: sending a message including a destination number from the mobile device to a callback computer, the ***message including information which requests a call from the mobile device to the destination number***; and establishing a connection by the callback computer between the mobile device of the participant and the destination number, wherein the connection is established only if a remaining credit of the participant exceeds a predetermined amount. Independent Claim 7 recites similar features in the context of a system for establishing connection with a mobile device.

As recited in the Specification from page 1, line 29 to page 2, line 2 and in corresponding Figure 1, Applicants' Claim 1 improves upon background telecommunication methods. For example, it makes it possible to establish a prepaid connection with a mobile device of a participant who is located in a visited Public Land Mobile Network (PLMN).

Turning now to the applied references, Donovan discloses a call delivery system for delivering a call to a mobile unit on a vehicle and Kennedy discloses a mobile switching center for accepting calls from a wireless handset. Donovan and Kennedy, however, fail to teach or suggest Applicants' claimed telecommunications method for establishing a connection with a mobile device of a participant. In particular, and as acknowledged by the outstanding Office Action,⁴ Donovan as well as Kennedy fail to teach or suggest sending a message from the mobile device to a callback computer, the message including information which requests a call from the mobile device to the destination number, as claimed.

The outstanding Office Action rejects Applicants' Claim 1 based on the proposition that Ekstrom discloses a short message from the mobile device to a call back computer,⁵ and that it would have been obvious to modify Donovan and Kennedy by importing this feature from Ekstrom to arrive at Applicants' Claim 1. However, Applicants respectfully disagree

⁴ See outstanding Office Action at page 3, lines 18-19.

⁵ See outstanding Office Action from page 3, line 20, to page 4, line 4.

and submit that Ekstrom fails to disclose the claimed message including information which requests a call from the mobile device to the destination number, as next discussed.

The outstanding Office Action relies on Ekstrom's text at column 3, lines 38-56, and column 4, lines 29-49. In this passage, Ekstrom recites "the reference to simulated call connections shall be understood as meaning that the call is released subsequent to having obtained desired signalling [sic] information, and also as meaning a call connection that an MS unit has been ordered to setup, via a modified SMS message. The transmission of the modified SMS message can also be considered *to initiate this latter simulation*"⁶ (emphasis added). In other words, Ekstrom proposes to involve the transmission of a modified short message (SMS) into a simulated call connection.⁷ However, Ekstrom fails to teach or suggest a message with information to request a call from the mobile device *to the destination number*, as recited in Applicants' Claim 1. As explained in Ekstrom, "the SMS commands to mobile station to carry out a position determining sequence" for a mobile station,⁸ and does not include a message including information to request a call to a destination number.

Therefore, even if the combination of Donovan, Kennedy and Ekstrom is *in arguendo* assumed to be proper, the combination fails to teach every element of the claimed invention. Accordingly, Applicants respectfully traverse, and request reconsideration of, these rejections based on these patents.⁹

Regarding the rejection of Claims 7, 9 and 11 under 35 U.S.C. §103(a), independent Claim 7 is amended to recite features similar to the features recited in independent Claim 1. Furthermore, the reference Kasai is concerned with a service to charge communication

⁶ See Ekstrom at column 4, lines 42-49.

⁷ See Ekstrom in the Abstract.

⁸ See Ekstrom in the Abstract, lines 10-12.

⁹ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

services to customers,¹⁰ and is entirely silent on sending messages including information to request a call, and establishing connection to a callback computer, and therefore does not remedy the deficiencies of Donovan, Kennedy and Ekstrom. Accordingly, even if *in arguendo* the combination of these references is assumed to be proper, Kasai also fails to teach or suggest ending messages including information to request a call. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejection of Claim 7, and all associated dependent claims, are also believed to be overcome in view of the arguments regarding independent Claim 1.

Regarding the remaining 35 U.S.C. §103(a) rejections, since the rejections of independent Claims 1 and 7 are believed to be overcome, the rejections of dependent Claims 2-6 and 8-14 are also believed to be overcome. Furthermore, none of the applied references Walker, Kasai, Alvesalo, Joensuu, and/or Sjödin, taken individually or in combination, remedy the deficiencies of the references Donovan, Kennedy and Ekstrom. All these references are silent on a message including information to request a call from the mobile device to the destination number, as recited in Applicants' independent Claims 1 and 7. Accordingly, Applicants respectfully request reconsideration of the remaining rejections of the dependent claims under 35 U.S.C. §103(a).

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-16 is earnestly solicited.

¹⁰ See Kasai in the Abstract.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Philippe J.C. Signore
Registration No. 43,922

Gregory J. Maier
Registration Number 25,599

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

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